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REMARKS

Claims 146, 148-201 and 217-232 are pending. Applicants thank the Examiner for indicating that Claims 146, 148, 153-171, 219, 220, 222 and 223 are allowed.

The undersigned thanks the Examiner for discussing this application with him by telephone on July 27, 2004. The undersigned explained to the Examiner that twelve (12) pages of a Declaration under 37 C.F.R. § 1.131 with Exhibit were filed in the USPTO on March 8, 2004. The twelve pages consisted of three copies of the Declaration with attached Exhibit (each copy consisted of 4 pages and was executed by one of the inventors). The undersigned also explained that the PAIR record for this application was inspected on June 8, 2004. Inspection of the electronic file wrapper indicated that only one copy of the Declaration with attached Exhibit (executed by Inventor Zabel) was entered into the USPTO file.

The Examiner confirmed that only one copy of the Declaration and Exhibit (copy executed by Inventor Zabel) was in the USPTO file. The Examiner also stated that he would consider the complete Declaration with Exhibit if a copy was filed, together with an Amendment After Final requesting reconsideration of the rejections under 36 U.S.C. §§ 102 and 103, and evidence that the complete Declaration was timely filed.

A copy of the Declaration and Exhibit that was filed on March 8, 2004 (12 pages; 3 documents each consisting of a Declaration signed by one of the inventors (3 pages) and attached Exhibit (1 page)) is provided herewith. Also provided is a copy of the postcard receipt submitted with the Declaration, evidencing receipt of the complete Executed Declaration Under 37 C.F.R. § 1.131 w/Exhibit (3 docs, 12 pages) in the USPTO on March 8, 2004.

Claims 182, 190-192, 200 and 201 have been amended. Support for the amendments to Claims 182 and 192 is found throughout the application as filed, for example, in Fig. 14A-14B. Claims 190, 191, 200 and 201 have been amended to recite "GPR-9-6" in conformity with the language of base Claims 182 and 192.

The amended claims are supported by the application as originally filed. Therefore, this Amendment adds no new matter.

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Paragraph 2. Rejection of Claims 182, 183, 185-193, 195-201, 217-218 and 229-232 Under 35 U.S.C. § 112, First Paragraph

Claims 182, 183, 185-193, 195-201, 217-218 and 229-232 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner states that the rejection of these claims has been maintained because the rejection was based in part upon the 90% similarity language in the claims, and that the specification does not contain sufficient written description of the genus of antibodies that inhibit binding of TECK to a GPR-9-6 that has at least about 90% amino acid sequence similarity to SEQ ID NO:2. (Office Action at page 2.)

It appears that Claims 217 and 218 were included in the rejection in error. Claims 217 and 218 are dependent upon allowed Claim 146 and are drawn to particular types of antibodies or antigen-binding fragments. The specification contains adequate written description for the particular types of antibodies or antigen-binding fragments recited in Claims 217 and 218. In addition, Claims 222 and 223, which are drawn to use of the same types of antibodies or antigen-binding fragments (human, humanized, chimeric, Fab, Fab', F(ab')₂ and Fv), are allowed.

Independent Claims 182 and 192 have been amended to recite that the antibody or antigen-binding fragment "inhibits binding of TECK to a GPR-9-6 encoded by SEQ ID NO:1," thereby obviating the rejection of Claims 182 and 192 and of dependent Claims 183, 185-191, 193, 195-201 and 229-232.

Reconsideration and withdrawal of the rejection are requested.

Rejections Under 35 U.S.C. §§ 102 and 103

Paragraph 3. Rejection of Claims 151, 152, 172-180, 192-200, 221 and 224-226 Under 35 U.S.C. § 102(a)

Claims 151, 152, 172-180, 192-200, 221 and 224-226 are rejected under 35 U.S.C. § 102(a) as being anticipated by Zabel *et al.* (Reference AR3 of record.)

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Paragraph 4. Rejection of Claims 151, 152, 172-181, 192-201, 221 and 224-226 Under 35 U.S.C. § 103(a)

Claims 151, 152, 172-181, 192-201, 221 and 224-226 are rejected under 35 U.S.C. § 103(a) as being obvious over Zaballos *et al.* (Reference AX2 of record) in view of Chuntharapai *et al.* (Reference AY2 of record).

Paragraph 5. Rejection of Claims 227, 228, 231 and 232 Under 35 U.S.C. § 103(a)

Claims 227, 228, 231 and 232 are rejected under 35 U.S.C. § 103(a) as being obvious over Zaballos *et al.* (Reference AX2 of record) in view of Chuntharapai *et al.* (Reference AY2 of record) and in further view of Chuntharapai *et al.* (U.S. Patent No. 5,440,021).

Paragraph 6. Rejection of Claims 181, 201, 227, 228, 231 and 232 Under 35 U.S.C. § 103(a)

Claims 181, 201, 227, 228, 231 and 232 are rejected under 35 U.S.C. § 103(a) as being obvious over Zabel *et al.* (Reference AR3 of record) in view of Chuntharapai *et al.* (U.S. Patent No. 5,440,021).

The Examiner maintained the rejections under 35 U.S.C. §§ 102 and 103, stating that the Declaration Under 37 C.F.R. § 1.131 was not considered because it was not properly executed. (Office Action at page 4.)

As discussed above, a complete Declaration und 37 C.F.R. § 1.131 with Exhibit properly executed by inventors Andrew, Zabel and Ponath, was filed in the USPTO on March 8, 2004, and a copy of that Declaration is provided herewith.

Zabel *et al.* was published in the *Journal of Experimental Medicine*, volume 190, number 9, which bears a cover date of November 1, 1999. The Declaration Under 37 C.F.R. § 1.131 presents evidence that the inventors produced mAb GPR96-1 and were in possession of the claimed invention before the effective date of Zabel *et al.* Therefore, Zabel *et al.* is not available as prior art under 35 U.S.C. § 102(a) and cannot be used in a rejection under § 103.

Zaballos *et al.* was published in *The Journal of Immunology*, volume 162, number 10, which bears a cover date of May 15, 1999. Information downloaded from *The Journal of Immunology* web site indicates that this volume of the journal was posted on-line on May 11, 1999. (Copy provided as Exhibit A with the Amendment filed on March 8, 2004.) As discussed above, the Declaration Under 37 C.F.R. § 1.131 presents evidence that the inventors produced

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mAb GPR96-1 and were in possession of the claimed invention prior to the effective date of Zaballos *et al.* Therefore, Zaballos *et al.* is not available as prior art under 35 U.S.C. § 102 and cannot be used in a rejection under § 103.

Reconsideration and withdrawal of the rejection are requested.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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Dated: August 5, 2004